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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,879	09/22/2003	Hideharu Takezawa	43888-276	4252
7590	06/27/2007		EXAMINER	
MCDERMOTT, WILL & EMERY 600 13th Street, N.W. Washington, DC 20005-3096			HODGE, ROBERT W	
			ART UNIT	PAPER NUMBER
			1745	
			MAIL DATE	DELIVERY MODE
			06/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/664,879	TAKEZAWA ET AL.
	Examiner	Art Unit
	Robert Hodge	1745

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 April 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1 and 5-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1 and 5-7 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 30 April 2007 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

**DETAILED ACTION*****Response to Arguments***

Applicant's arguments, see Remarks, filed 4/30/07; with respect to the rejection of claims 1 and 6 under 35 U.S.C. 112, second paragraph have been fully considered and are persuasive. The rejection of claims 1 and 6 under 35 U.S.C. 112, second paragraph has been withdrawn.

Applicant's arguments filed 4/30/07 have been fully considered but they are not persuasive. With regards to the objection to claim 7 as being a duplicate claim of claim 5 applicants state that claim 5 is directed to an electrode group and claim 7 is directed to a non-aqueous electrolyte secondary battery. This is not found persuasive because the structure recited in both claims is identical and the only difference is in the preamble of each of the claims. It is also clear that the electrode group of claim 5 is being used in a battery as outlined in independent claim 1 of the instant application, from which claims 5 and 7 both depend. Therefore the objection will be maintained.

Applicants further state that AAPA and Anzai fail to disclose a plurality of steps. As applicants explained in their Remarks with regards to the rejection of claims 1 and 6 under 35 U.S.C. 112, second paragraph, the end of the separator is a step portion and either side of the positive electrode lead also provide step portions. Therefore as seen in figure 3, the end portion 19 of the separator and either side of the positive electrode lead 11c constitute the plurality of step portions. Furthermore it is noted that figures 1 and 3 of the instant application are almost identical. The only difference is that figure 1 has an additional insulating layer 5, which is not present in the prior art figure 3. Other

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than the one difference the figures are identical and therefore have all of the same structural features that are outlined in the claims except for the insulating layer. Thus the reason the Examiner used the Anzai reference. Applicants state that Anzai's ionic insulator appears to be the separator. However it is clear that Anzai teaches the ionic insulator in addition to a separator since a separator is clearly discussed separately from the ionic insulator see the abstract and paragraph [0026]. Therefore it is the Examiner's position that it would still be obvious to a skilled artisan to include the ionic insulating layer of Anzai in AAPA, which would then form the instantly claimed invention and the rejections will be maintained.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicants are also directed to MPEP 2145 (I-II):

I. ARGUMENT DOES NOT REPLACE EVIDENCE WHERE EVIDENCE IS  
NECESSARY

Attorney argument is not evidence unless it is an admission, in which case, an examiner may use the admission in making a rejection. See MPEP § 2129 and § 2144.03 for a discussion of admissions as prior art. The arguments of counsel cannot take the place of evidence in the

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record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965); *In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997) ("An assertion of what seems to follow from common experience is just attorney argument and not the kind of factual evidence that is required to rebut a prima facie case of obviousness."). See MPEP § 716.01(c) for examples of attorney statements which are not evidence and which must be supported by an appropriate affidavit or declaration.

## II. ARGUING ADDITIONAL ADVANTAGES OR LATENT PROPERTIES

**Prima Facie Obviousness Is Not Rebutted by Merely Recognizing Additional Advantages or Latent Properties Present in the Prior Art** Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979) (Claims were directed to grooved carbon disc brakes wherein the grooves were provided to vent steam or vapor during a braking action. A prior art reference taught

noncarbon disc brakes which were grooved for the purpose of cooling the faces of the braking members and eliminating dust. The court held the prior art references when combined would overcome the problems of dust and overheating solved by the prior art and would inherently overcome the steam or vapor cause of the problem relied upon for patentability by applicants. Granting a patent on the discovery of an unknown but inherent function (here venting steam or vapor) "would re-move from the public that which is in the public domain by virtue of its inclusion in, or obviousness from, the prior art." 596 F.2d at 1022, 201 USPQ at 661.); *In re Baxter Travenol Labs.*, 952 F.2d 388, 21 USPQ2d 1281 (Fed. Cir. 1991) (Appellant argued that the presence of DEHP as the plasticizer in a blood collection bag unexpectedly suppressed hemolysis and therefore rebutted any prima facie showing of obviousness, however the closest prior art utilizing a DEHP plasticized blood collection bag inherently achieved same result, although this fact was unknown in the prior art.).

"The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences

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would otherwise be obvious." Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985)

(The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art.). See also Lantech Inc. v. Kaufman Co. of Ohio Inc., 878 F.2d 1446, 12 USPQ2d 1076, 1077 (Fed. Cir. 1989), cert. denied, 493 U.S. 1058 (1990) (unpublished — not citable as precedent) ("The recitation of an additional advantage associated with doing what the prior art suggests does not lend patentability to an otherwise unpatentable invention."). In re Lintner, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) and In re Dillon, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990) discussed in MPEP § 2144 are also pertinent to this issue.

The Examiner acknowledges that the drawings have been properly amended to label figures 3 and 4 as Prior Art and said amendment is accepted by the Examiner and will be entered.

### ***Claim Objections***

Claim 7 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 5. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admitted Prior Art hereinafter AAPA in view of JP-11-27339 hereinafter Anzai.

As can clearly be seen in figure 3 of the instant application and described in applicants background section, AAPA teaches the instantly claimed invention except for the insulating member that covers a separator and current collector from an inner side of said electrode group.

Anzai teaches a non-aqueous electrolyte secondary battery having a spiral electrode group formed by winding positive and negative electrodes having a separator interposed between and a battery case for housing said electrode group. Anzai also teaches that the positive electrode includes a current collector and positive electrode material which when wound would be on both sides of the current collector and the negative electrode includes a current collector and negative electrode material which when wound would be on both sides of the current collector and tabs would be respectively connected to the current collectors. Anzai further teaches the necessity for the use of an ionic insulator arranged at an innermost or outermost circumferential side at the end (or step as applicants define in their specification) of the positive electrode and is adhered to a position opposing the end (abstract, paragraphs [0016]-[0021] and [0026]-[0038]).

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At the time of the invention it would have been obvious to one having ordinary skill in the art to include an ionic insulator in AAPA as taught by Anzai in order to prevent short circuiting of the electrode group within the battery thereby increasing the battery life and reducing any possible explosion hazards from the short circuit igniting hydrogen that is created during discharge of the battery.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert Hodge whose telephone number is (571) 272-2097. The examiner can normally be reached on 8:00am - 4:30pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on (571) 272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RWH

*J.C.*  
JONATHAN CREPEAU  
PRIMARY EXAMINER